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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,336	09/25/2007	Konrad Kemper	2400.0740000/RWE/DAS	2752

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

BROWN, COURTNEY A

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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06/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,336	Applicant(s) KEMPER ET AL.	
	Examiner COURTNEY BROWN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/23/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Receipt/Status of Claims

This Office Action is in response to the amendment filed March 3, 2010. Claims 14 and 16 are pending in the application. Claims 1-13, 15 and 17 have been cancelled. Claims 14 and 16 are being examined for patentability.

Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

Information Disclosure Statement

The Information Disclosure Statements (IDS) submitted on April 23, 2010 been considered by the examiner.

Withdrawn Rejections/Objections

Applicant's arguments, see pages 4-11, filed April 23, 2010, with respect to the objection of claim 9 have been fully considered and is moot in view of the cancellation of claim 9. Therefore, the objection has been **withdrawn**.

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Applicant's arguments, see pages 4-11, filed April 23, 2010, with respect to the 112 rejection of claim 9 have been fully considered and is moot in view of the cancellation of claim 9. Therefore, the rejection has been **withdrawn.**

Applicant's arguments, see pages 4-11, filed April 23, 2010, with respect to the 102/103 Alternative rejection of claims 3, 9 and 11 has been fully considered and is moot in view of the cancellation of claims 3, 9 and 11. Therefore, the rejection has been **withdrawn.**

New Rejection(s) Necessitated by the Amendment filed on March 3, 2010

Claim Rejections- 35 USC § 102/103 Alternative

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Asrar et al. (US Patent 7,098,170 B2, cited in the previous rejection on November 10, 2009).

Asrar et al. disclose a method of increasing the vigor and/or the yield of an agronomic plant that is a member of the class Magnolisopida, specifically a soybean plant (claims 1, 18 and 23 of Asrar et al.). Said method comprises treating the plant or its propagation material with an effective amount of **fluquinconazole** and/or azoxystrobin (claims 1, 3 and 10 of Asrar et al.). The plant or its propagation material comprises seed that is treated with an amount of fungicide in an amount from about 0.1 gm/100 kg of seed to about 1,000 gm/100 kg of seed (claims 1 and 12 of Asrar et al.). Thus, the seeds of Asrar et al. are inherently protected against soya bean rust.

Asrar et al. disclose all the limitations of the instant claims wherein soybean and seed are treated with fluquinconazole **alone** and/or in combined with azoxystrobin which inherently protects the soybean from soybean rust.

If one argues that the claimed method is not taught, it would be obvious to one of ordinary skill in the art to assume that a method of increasing the vigor and/or the yield of a soybean plant comprising treating the plant or its propagation material with an effective amount of fluquinconazole and/or azoxystrobin would protect said soybean from rust. The burden of proof has been shifted to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02.

In reference to a method for protecting transgenic soybeans using a composition comprising fluquinconazole and prothioconazole or tolylfluanid, it is the Examiner's position that it is known to one of ordinary skill in the art that a fungicide that works to protect regular soybean plants will also work to protect transgenic soybeans in manner in absence of evidence to the contrary. Further, Asrar et al. disclose that that plants and plant propagation material that are suitable for use in their invention can be non-transgenic plants, or can be plants that have at least one **transgenic event**.

Response to Arguments

Applicant's arguments filed on April 23, 2010, with respect to the 103 rejection of claims 14 and 16 under 35 U.S.C. 103(a) as obvious being over Asrar et al. (US Patent 7,098,170 B2) in view of Ammermann et al. (US Patent Application 2005/0165076 A1) and Suarez-Cervieri et al. (US Patent Application 20050032903) have been fully considered but are moot in view of the new grounds of rejection. However, the Examiner has addressed Applicant's arguments pertaining to Asrar et al. since the reference is used in the instant rejection.

Applicant argues that Asrar et al. do not disclose soy bean rust, or even the *Phakospora* fungal species known to cause soybean rust and do not disclose protecting soy bean plants susceptible to subsequent attack by phytopathogenic fungi. Rather, Applicant argues that the disclosure of Asrar et al. is directed to a "method of increasing the vigor and/or the yield of an agronomic plant ..." In rendering the rejection, Applicant argues that the Examiner failed to give weight to the "material acted upon," i.e., soya

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bean plants subject to subsequent attack by phytopathogenic fungi. However, the Examiner disagrees with Applicant's arguments because Asrar et al. disclose all the limitations of the instant claims wherein soybean and seed are treated with fluquinconazole **alone** and/or in combined with azoxystrobin which inherently protects the soybean from soybean rust. Further, it is duly noted that the composition of the prior art is the same as Applicant's composition. Thus, the skilled artisan would recognize that a composition is inseparable from its properties. Hence, all the properties associated with Applicant's compositions would also be possessed by the compositions of the prior art.

***Examiner's Response to the 37 C.F.R. §1.132 Declaration
Of Anne Suty-Heinze***

The 37 C.F.R. Declaration of Anne Suty-Heinze have been fully considered but they are not persuasive. In the arguments filed on March 3, 2010 (see page 10_, Applicant argues that that the Declaration of *Anne Suty-Heinze* indicates that applying fluquinconazole to the seed of soya bean plants to protect soya bean plants against soya bean rust provides results comparable to the use of a combination of fungicides. Applicant argues that these results are clearly unexpected in view of the requirement in the cited art of (i) absence of pest pressure by fungal plant pathogens; and (ii) combinations of fungicides, and would render moot any showing of prima facie obviousness. However the declaration of Anne Suty-Heinze is not convincing because

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the prior art, Asrar et al., disclose all the limitations of the instant claims wherein soybean and seed are treated with fluquinconazole alone and/or in combination with azoxystrobin which inherently protects the soybean from soybean rust. Further, upon review of the data, applying fluquinconazole to the seed of soya bean in comparison to applying fluquinconazole in combination with trifloxystrobin or azoxystrobin is not comparable. The data shows that fluquinconazole, when applied alone, gives an efficacy of 80 and a phytotoxicity of 0. When fluquinconazole in combination with trifloxystrobin or azoxystrobin is applied to seed, the data shows that these seed treatments give an efficacy of 91 and a phytotoxicity of 0. Thus, because the prior art teaches seed treated with fluquinconazole alone and/or in combination with azoxystrobin and the data submitted in the declaration provides results that are not comparable to the use of a combination of fungicides versus the use of fluquinconazole alone, the instant claims are not allowable.

Conclusion

The claims remain rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney A. Brown whose telephone number is 571-270-3284. The examiner can normally be reached on 9:00 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Courtney A. Brown
Patent Examiner
Technology Center 1600
Group Art Unit 1616

/Ernst V Arnold/
Primary Examiner, Art Unit 1616